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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,062	12/31/2001	William R. Matz	60027.101US01	9118
21552	7590	02/11/2005	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			REILLY, SEAN M	
			ART UNIT	PAPER NUMBER
			2153	
DATE MAILED: 02/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/039,062	<b>Applicant(s)</b> MATZ ET AL.	
	<b>Examiner</b> Sean Reilly	<b>Art Unit</b> 2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is a first action on the merits of this application. Claims 1-22 are presented for further examination.

#### *Priority*

1. The effective filing date for the subject matter defined in the pending claims in this application is 12/31/2001.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Regarding claims 21-22, the limitation “a computer program product readable by a computer and having stored thereon a data structure” reads on non-statutory subject matter. The specification states “communication media typically embody data structures in a modulated data signal such as a carrier wave or other transport mechanism” (Specification pg 8). It would be not unreasonable to interpret such a definition to mean that *the computer program product readable by a computer* may be a carrier wave or other non-statutory “transport mechanism.” Since the claimed computer program product is not necessarily tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas.

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4. In further considering claims 21-22, the data structure as claimed may not be executable and is therefore non-statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al. (U.S. Patent Number 6,327,574; hereinafter Kramer).

6. Regarding claim 1, Kramer discloses a method of providing targeted media content in a distributed network, the distributed network having a client device and a server device, the method comprising:

- storing a user profile (Col 10, lines 41-45) having one or more user profile tags (characteristic values) corresponding to user classifications (Col 10, lines 51-57 and lines 59-61);
- receiving a plurality of tagged content items (e.g. Commercials), each having a targeting tag (selection criteria) (Col 9, lines 48-51; or for a webpage Col 8, lines 24-31);

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- evaluating the plurality of tagged content items in view of the user profile (Col 8, lines 34-37); and
- presenting one of the plurality of tagged content items based on the evaluation (Col 8, lines 34-40).

7. Regarding claim 2, Kramer discloses storing further comprises defining a user profile based on usage (Col 3, lines 10-14).

8. Regarding claim 3, Kramer discloses storing further comprises defining a user profile based on manual input (Col 10, lines 32-33 and Col 14, lines 36-42); information manually entered on forms).

9. Regarding claim 4, Kramer discloses the method is performed by a television set-top-box and wherein the distribution network is a television broadcast network (Col 5, lines 8-9).

10. Regarding claim 5, Kramer discloses the method is performed by a computer device and wherein the distribution network is the Internet (Col 5, lines 5-8).

11. Regarding claims 6 and 7, Kramer discloses the receiving act further comprises storing the tagged content in an organized manner (inherent in order for the content to be selected and displayed; e.g. commercial Col 9, lines 48-53).

12. Regarding claim 8, Kramer discloses a plurality of tag identifiers, the tag identifiers corresponding to user tag identifiers in the user profile tags (characteristic values; Col 11, lines 1-10), and wherein the evaluating act compares corresponding tag identifiers and user tag identifiers to determine a score (appeal function) for associated tag information (Col 11, lines 17-21).

13. Regarding claim 9, Kramer discloses recognizing a content insertion event (illumination, Col 6, lines 22-24; e.g. detecting an insertion event (variable content) in a webpage Col 8, lines 24-31 or during a TV broadcast selecting a commercial to insert Col 9, lines 45-53); and presenting one or more content items in response to recognizing the content insertion event (Col 8, lines 24-31; Col 17, lines 40-47; or Col 9, lines 45-53).

14. Regarding claims 10 and 12, Kramer discloses the recognizing act comprises receiving an internal content insertion event such as a user initiated menu (webpage or content rotator) selection for content (user selecting a link on a webpage and the displayed webpage showing customized content, Col 8, lines 44-54; or Col 31, lines 56-61)).

15. Regarding claims 11 and 13, Kramer discloses the recognizing act comprises receiving an external content insertion event (Col 9, lines 45-53) such as for advertising events (Commercials).

16. Regarding claim 14, Kramer discloses a client device for providing targeted content comprising:

- a user profile (Col 10, lines 41-45) having one or more user profile tags (characteristic values) associated with user preferences (Col 10, lines 51-57 and lines 59-61);
- a tagged content memory storing a plurality of content items (Col 5, line 5; e.g. Commercials, storage is needed in order for the tagged content to be presented to the user), each having an associated tag associated with classes of targeted users (selection criteria) (Col 9, lines 48-51);

- a filtering module operable to filter out a content item whose associated tag is not sufficiently similar to any of the one or more user profile tags (Col 13, lines 6-19); and
- a user input/output module (inherent) operable to present content to a user of the client device (inherent for the functionality of presenting content to user, e.g. a selected commercial out of a set-top-box, Col 9, lines 45-53) and further operable to detect a content selection from the user (user input; Col 3, lines 10-21);

17. Regarding claim 15, Kramer further discloses a profile generator module (Report Interpreter/Modeling Engine) in operable communication with the user input/output module and the user profile, operable to update the user profile based on the content selection from the user (Col 12, lines 54-67; Col 13, lines 1-5).

18. Regarding claim 16, Kramer further discloses a content insertion engine in operable communication with the user input/output model and the filtering module, operable to detect a user initiated insertion event and request from the filtering module an appropriate content item based on the user selection and the user profile (Col 13, lines 5-19).

19. Regarding claim 17, Kramer further discloses a receiving module operable to receive tagged content from a communication network; and a storage module in operable communication with the receiving module and the filtering module, operable to store the received tagged content and provide the tagged content to the filtering module (Col 8, lines 24-40).

20. Regarding claim 18, Kramer further discloses a media content distribution network comprising: a server device providing tagged media content (Figure 1; 106); and a client device

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in operable communication with the server device, operable to receive all tagged media content and select the tagged media content that most closely matches a user profile (Figure 1, 102).

21. Regarding claims 19-20, claims 19-20 are similarly drawn to the limitations of claim 14, thus they are rejected using similar rationale.

22. Regarding claims 21 and 22, Kramer discloses a network environment having a server device and client device, a computer program product readable by a computer and having stored thereon a data structure, comprising: a data stream having content that may be present to a user; and a tag associated with the data stream, the tag comprising information related to the predetermined user classifications (selection criteria) (Col 9, lines 45-53).

### ***Conclusion***

23. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

24. This office action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

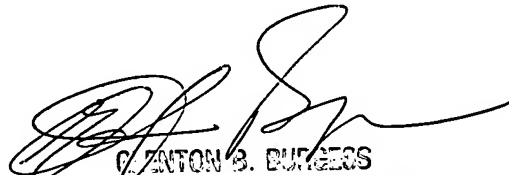
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
2/3/2005

  
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